

Model Patent Jury Instructions  
for the Northern District of California

January 18, 2002

Working Committee

Martin Fliesler – Chair  
Professor Mark Lemley  
David McIntyre  
James Pooley  
Matthew Powers  
Honorable Ronald Whyte  
James Yoon

## **I. Introduction**

These Model Patent Jury Instructions have been adopted by the Northern District of California as model patent instructions. The court intends to revise these instructions as needed to make them more complete and to ensure compliance with Federal Circuit decisions. The court is indebted to the Working Committee which spent many hours drafting these model instructions. The court also appreciates the input provided by the Advisory Committee consisting of Professor Donald Chisum, Santa Clara University, chair, Professor Janice Mueller, John Marshall Law School, Professor Paul Janicke, University of Houston and Professor Craig Nard, Marquette University.

The instructions have been prepared to assist judges in communicating effectively and in plain English with jurors in patent cases. The instructions are models and are not intended to be used without tailoring. They are not substitutes for the individual research and drafting that may be required in a particular case.

The instructions include only instructions on patent law. They will need to be supplemented with standard instructions on, among other things, the duties of the judge and jury, the consideration of evidence, the duty to deliberate, and the return of a verdict. The Ninth Circuit Manual of Model Jury Instructions (Civil 2001) is a good reference for standard instructions for civil cases.

The model instructions use the terms “patent holder” and “alleged infringer” in brackets. The names of the parties should be substituted for these terms as appropriate. Other language is bracketed as it may not be appropriate for a particular case. Empty brackets signify additional case specific information to be added, such as patent or claim numbers.

Suggested revisions to these instructions may be sent to the Honorable Ronald M. Whyte at the e-mail address: [Ronald\\_Whyte@cand.uscourts.gov](mailto:Ronald_Whyte@cand.uscourts.gov) or at his U.S. mail address: U.S. Court Building, 280 S. First Street, San Jose, California 95113.

## **II. Table of Contents**

### **A. Preliminary Instructions**

1. What a Patent Is and How One is Obtained
2. Patent At Issue
3. Summary of Contentions
4. Overview of Applicable Law
5. Outline of Trial

### **B. Instructions at Close of Evidence**

1. Summary of Contentions
2. Claim Construction
  - 2.1 Interpretation of Claims
3. Infringement
  - 3.1 Infringement – Burden of Proof
  - 3.2 Direct Infringement
  - 3.3 Literal Infringement
  - 3.4 Infringement Under the Doctrine of Equivalents
  - 3.5 Means-Plus-Function Claims – Literal Infringement
  - 3.6 Means-Plus-Function Claims – Infringement Under the Doctrine of Equivalents
  - 3.7 Limitations on the Doctrine of Equivalents
  - 3.8 Indirect Infringement – Generally
  - 3.9 Contributory Infringement
  - 3.10 Inducing Patent Infringement
  - 3.11 Willful Infringement
4. Validity
  - 4.1 Invalidity – Burden of Proof
  - 4.2 Adequacy of Patent Specification
    - 4.2a Written Description
    - 4.2b Enablement
    - 4.2c Best Mode
  - 4.3 The Claims
    - 4.3a1 Anticipation
    - 4.3a2 Statutory Bars
    - 4.3b Obviousness
      - 4.3bi Scope and Content of Prior Art

- 4.3bii Differences Over the Prior Art
- 4.3biii Level of Ordinary Skill
- 4.3c Inventorship

5. Patent Damages

- 5.1 Damages – Burden of Proof
- 5.2 Lost Profits – Generally
- 5.3 Lost Profits – Factors to Consider
- 5.4 Lost Profits – Collateral Sales
- 5.5 Lost Profits – Price Erosion
- 5.6 Reasonable Royalty – Entitlement
- 5.7 Reasonable Royalty – Definition
- 5.8 Date of Commencement – Products

C. Appendix

## **WHAT A PATENT IS AND HOW ONE IS OBTAINED**

This case involves a dispute relating to a United States patent. Before summarizing the positions of the parties and the legal issues involved in the dispute, let me take a moment to explain what a patent is and how one is obtained.

Patents are granted by the United States Patent and Trademark Office (sometimes called “the PTO”). The process of obtaining a patent is called patent prosecution. A valid United States patent gives the patent owner the right [for up to 20 years from the date the patent application was filed] [for 17 years from the date the patent issued] to prevent others from making, using, offering to sell, or selling the patented invention within the United States or from importing it into the United States without the patent holder’s permission. A violation of the patent owner’s rights is called infringement. The patent owner may try to enforce a patent against persons believed to be infringers by a lawsuit filed in federal court.

To obtain a patent one must file an application with the PTO. The PTO is an agency of the federal government and employs trained examiners who review applications for patents. The application includes what is called a “specification,” which must contain a written description of the claimed invention telling what the invention is, how it works, how to make it and how to use it so others skilled in the field will know how to make or use it. The specification concludes with one or more numbered sentences. These are the patent “claims.” When the patent is eventually granted by the PTO, the claims define the boundaries of its protection and give notice to the public of those boundaries.

After the applicant files the application, a PTO patent examiner reviews the patent application to determine whether the claims are patentable and whether the specification adequately describes the invention claimed. In examining a patent application, the patent examiner reviews records available to the PTO for what is referred to as “prior art.” The examiner also will review prior art if it is submitted to the PTO by the applicant. Prior art is defined by law, and I will give you at a later time specific instructions as to what constitutes prior art. However, in general, prior art includes things, which existed before the claimed invention, that were publicly known, or used in a publicly accessible way in this country, or that were patented or described in a publication in any country. The examiner considers, among other things, whether each claim defines an invention that is new, useful, and not obvious in view of the prior art. A patent lists the prior art which the examiner considered; this list is called the “cited references.”

After the prior art search and examination of the application, the patent examiner then informs the applicant in writing what the examiner has found and whether any claim is patentable, and thus would be “allowed.” This writing from the patent examiner is called an “office action.” If the examiner rejects the claims, the applicant then responds and sometimes changes the claims or submits new claims. This process, which is confidential between the examiner and the patent applicant, may go back and forth for some time until the examiner is satisfied that the application and claims meet the requirements for a patent. The papers generated during this time of communicating back and forth between the patent examiner and the applicant make up what is

called the “prosecution history.” All of this material is kept secret between the applicant and the PTO for some time, often until the patent is issued, when it becomes available to the public.

The fact that the PTO grants a patent does not necessarily mean that any invention claimed in the patent, in fact, deserves the protection of a patent. [The patent, when granted by the PTO, is presumed to be valid but its validity can be challenged by others.]<sup>1</sup> A person accused of infringement has the right to argue here in federal court that a claimed invention in the patent is invalid because it does not meet the requirements for a patent.

---

<sup>1</sup> The Committee members disagree on whether this bracketed sentence instructing on the presumption of validity should be given. Those recommending against such an instruction contend that once the jury is properly instructed on the burden of proof on invalidity, an instruction on the presumption is redundant and potentially confusing. The presumption itself is not entitled to any evidentiary weight and, therefore, an instruction on the presumption, in addition to giving the jury the effect of the presumption, may suggest that it has some separate evidentiary weight. *See SSIH Equipment S.A. v. United States International Trade Com.*, 718 F.2d 365, 365 (Fed. Cir. 1983) (“The presumption of validity afforded by 35 U.S.C. § 282 does not have independent evidentiary value. Rather the presumption places the burden of going forward, as well as the burden of persuasion, upon the party asserting invalidity.”); *Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1562 (Fed. Cir. 1988) (“[T]he presumption is a procedural device, which assigns the burden of going forward as well as the burden of proof of facts to the challenger. . . . [T]he presumption is one of law, not fact, and does not constitute “evidence” to be weighed against a challenger’s evidence.”).

Those Committee members recommending that an instruction on the presumption be given assert that 35 U.S.C. § 282 specifically provides for a presumption of validity and the jury is entitled to know that.

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

35 U.S.C. § 282. They further point out that the Federal Circuit has discussed the accuracy of instructions on the effect of the presumption and never held that it is improper to instruct on the presumption itself. *See, for e.g., Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557 (Fed. Cir. 1993). An instruction on the presumption tells the jury why the burden of proof is clear and convincing evidence.

*A.2. Preliminary Instructions*

**PATENT AT ISSUE**

[The court should show the jury the patent at issue and point out the parts including the specification, drawings and claims including the claims at issue. The court could at this point also hand out its construction of any claim terms and the glossary.]

### *A.3. Preliminary Instructions*

#### **SUMMARY OF CONTENTIONS**

To help you follow the evidence, I will now give you a summary of the positions of the parties.

The parties in this case are [patent holder] and [alleged infringer]. The case involves a United States patent obtained by [inventor], and transferred by [inventor] to [patent holder]. The patent involved in this case is United States Patent Number [patent number] which lists [inventor] as the inventor. For convenience, the parties and I will often refer to this patent as the [last three numbers of the patent] patent, [last three numbers of patent] being the last three numbers of its patent number.

[Patent holder] filed suit in this court seeking money damages from [alleged infringer] for allegedly infringing the [ ] patent by [making], [importing], [using], [selling], and [offering for sale] [products] [methods] that [patent holder] argues are covered by claims [ ] of the patent. [[Patent holder] also argues that [alleged infringer] has [actively induced infringement of these claims of the [ ] patent by others] [and] [contributed to the infringement of these claims of the [ ] patent by others].] The [products] [methods] that are alleged to infringe are [list of accused products or methods].

[Alleged infringer] denies that it has infringed claims [ ] of the [ ] patent and argues that, in addition, the claims are invalid. [Add other defenses, if applicable].

Your job will be to decide whether claims [ ] of the [ ] patent have been infringed and whether those claims are invalid. If you decide that any claim of the [ ] patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to [patent holder] to compensate it for the infringement. [You will also need to make a finding as to whether the infringement was willful. If you decide that any infringement was willful, that decision should not affect any damage award you give. I will take willfulness into account later.]

It is my job as judge to determine the meaning of any claim language that needs interpretation. You must accept the meanings I give you and use them when you decide whether any claim of the patent has been infringed and whether any claim is invalid.

#### *A.4. Preliminary Instructions*

### **OVERVIEW OF APPLICABLE LAW**

[The court may want to consider giving preliminary instructions on the patent law applicable to the specific issues in the case. This could help focus the jury on the facts relevant to the issues it will have to decide. If this is done, the instructions intended to be given after the close of evidence could be adapted and given as preliminary instructions. This, of course, would not negate the need to give complete instructions at the close of evidence.]

### *A.5. Preliminary Instructions*

## **OUTLINE OF TRIAL**

The trial will now begin. First, each side may make an opening statement. An opening statement is not evidence. It is simply an outline to help you understand what that party expects the evidence will show.

There are two standards of proof that you will apply to the evidence, depending on the issue you are deciding. On some issues, you must decide whether something is more likely true than not. On other issues you must use a higher standard and decide whether it is highly probable that something is true.

[Patent holder] will then present its evidence on its contention that [some] [the] claims of the [ ] patent have been [and continue to be] infringed by [alleged infringer] [and that the infringement has been [and continues to be] willful.] To prove infringement of any claim, [patent holder] must persuade you that it is more likely than not that [alleged infringer] has infringed that claim. [To persuade you that any infringement was willful, [patent holder] must prove that it is highly probable that the infringement was willful.]

[Alleged infringer] will go next and present its evidence that the claims of the [ ] patent are invalid. To prove invalidity of any claim, [alleged infringer] must persuade you that it is highly probable that the claim is invalid. In addition to presenting its evidence of invalidity, [alleged infringer] will put on evidence responding to [patent holder]’s infringement [and willfulness] contention[s].

[Patent holder] will then return and will put on evidence responding to [alleged infringer]’s contention that the claims of the [ ] patent are invalid. [Patent holder] will also have the option to put on what is referred to as “rebuttal” evidence to any evidence offered by [alleged infringer] of non-infringement [or lack of willfulness].

Finally, [alleged infringer] will have the option to put on “rebuttal” evidence to any evidence offered by [patent holder] on the validity of [some] [the] claims of the [ ] patent.

[During the presentation of the evidence, the attorneys will be allowed brief opportunities to explain what they believe the evidence has shown or what they believe upcoming evidence will show. Such comments are not evidence and are being allowed solely for the purpose of helping you understand the evidence.]

After the evidence has been presented, [the attorneys will make closing arguments and I will give you final instructions on the law that applies to the case] [I will give you final instructions on the law that applies to the case and the attorneys will make closing arguments]. Closing arguments are not evidence. After the [closing arguments and instructions] [instructions and closing arguments], you will then decide the case.

### *B.1. Summary of Contentions*

#### **SUMMARY OF CONTENTIONS**

I will first give you a summary of each side's contentions in this case. I will then tell you what each side must prove to win on each of its contentions. As I previously told you, [patent holder] seeks money damages from [alleged infringer] for allegedly infringing the [ ] patent by [making,] [importing,] [using,] [selling] and [offering for sale] [products] [methods] that [patent holder] argues are covered by claims [ ] of the patent. These are the asserted claims of the [ ] patent. [Patent holder] also argues that [alleged infringer] has [actively induced infringement of these claims of the [ ] patent by others] [contributed to the infringement of these claims of the [ ] patent by others]. The [products] [methods] that are alleged to infringe are [list of accused products or methods].

[Alleged infringer] denies that it has infringed the asserted claims of the patent and argues that, in addition, claims [ ] are invalid. [Add other defenses if applicable].

Your job is to decide whether the asserted claims of the [ ] patent have been infringed and whether any of the asserted claims of the [ ] patent are invalid. If you decide that any claim of the patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to [patent holder] to compensate it for the infringement. [You will also need to make a finding as to whether the infringement was willful. If you decide that any infringement was willful, that decision should not affect any damage award you make. I will take willfulness into account later.]

## *B.2. Claim Construction*

### **2.1 INTERPRETATION OF CLAIMS**

I have interpreted the meaning of some of the language in the patent claims involved in this case. You must accept those interpretations as correct. My interpretation of the language should not be taken as an indication that I have a view regarding the issues of infringement and invalidity. The decisions regarding infringement and invalidity are yours to make.

[Court gives its claim interpretation. This instruction must be coordinated with instruction 3.5 “Means-Plus-Function Claims—Literal Infringement” if the claims at issue include means-plus-function limitations.]

#### Authorities

*Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384-391 (1996); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1304-13 (Fed. Cir. 1999); *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448 (Fed. Cir. 1998) (*en banc*); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995) (*en banc*).

### *B.3. Infringement*

#### **3.1 INFRINGEMENT – BURDEN OF PROOF**

I will now instruct you on the rules you must follow in deciding whether [patent holder] has proven that [alleged infringer] has infringed one or more of the asserted claims of the [ ] patent. To prove infringement of any claim, [patent holder] must persuade you that it is more likely than not that [alleged infringer] has infringed that claim.

#### Authorities

*Seal-Flex, Inc. v. Athletic Track and Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1468-69 (Fed. Cir. 1993).

### B.3. Infringement

#### 3.2 DIRECT INFRINGEMENT

A patent's claims define what is covered by the patent. A [product] [method] directly infringes a patent if it is covered by at least one claim of the patent.

Deciding whether a claim has been directly infringed is a two-step process. The first step is to decide the meaning of the patent claim. I have already made this decision, [and I will instruct you later as to the meaning of the asserted patent claims] [and I have already instructed you as to the meaning of the asserted patent claims]. The second step is to decide whether [alleged direct infringer] has [made,] [used,] [sold,] [offered for sale] or [imported] within the United States a [product] [method] covered by a claim of the [ ] patent. You, the jury, make this decision.

[With one exception,] you must consider each of the asserted claims of the patent individually, and decide whether [alleged direct infringer]'s [product] [method] infringes that claim. [The one exception to considering claims individually concerns dependent claims. A dependent claim includes all of the requirements of a particular independent claim, plus additional requirements of its own. As a result, if you find that an independent claim is not infringed, you must find that its dependent claims are also not infringed. On the other hand, if you find that an independent claim has been infringed, you must still separately decide whether its asserted dependent claims have also been infringed].

There are two ways in which a patent claim may be directly infringed. A claim may be “literally” infringed, or it may be infringed under the “doctrine of equivalents.” The following instructions will provide more detail on these two types of direct infringement. [You should note, however, that what are called “means-plus-function” requirements in a claim are subject to different rules for deciding direct infringement. These separate rules apply to claims [ ]. I will describe these separate rules shortly].

#### Authorities

*Warner-Jenkinson Co., Inc. v. Hilton Davies Chemical Co.*, 520 U.S. 17 (1997); *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1330 (Fed. Cir. 2001); *Seal-Flex, Inc. v. Athletic Track and Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1576 (Fed. Cir. 1993).

### *B.3. Infringement*

#### **3.3 LITERAL INFRINGEMENT**

To decide whether [alleged infringer]'s [product] [method] literally infringes a claim of the [ ] patent, you must compare that [product] [method] with the patent claim and determine whether every requirement of the claim is included in that [product] [method]. If so, [alleged infringer]'s [product] [method] literally infringes that claim. If, however, [alleged infringer]'s [product] [method] does not have every requirement in the patent claim, [alleged infringer]'s [product] [method] does not literally infringe that claim. You must decide literal infringement for each asserted claim separately.

#### Authorities

*Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1353 (Fed. Cir. 2001); *Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1238 (Fed. Cir. 2001); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532 (Fed. Cir. 1996).

### B.3. Infringement

#### 3.4 INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

If you decide that [alleged infringer]’s [product] [method] does not literally infringe an asserted patent claim, you must then decide whether that [product] [method] infringes the asserted claim under what is called the “doctrine of equivalents.”

Under the doctrine of equivalents, the [product] [method] can infringe an asserted patent claim if it includes [parts] [steps] that are identical or equivalent to the requirements of the claim. If the [product] [method] is missing an identical or equivalent [part] [step] to even one requirement of the asserted patent claim, the [product] [method] cannot infringe the claim under the doctrine of equivalents. Thus, in making your decision under the doctrine of equivalents, you must look at each individual requirement of the asserted patent claim and decide whether the [product] [method] has an identical or equivalent [part] [step] to that individual claim requirement.

A [part] [step] of a [product] [method] is equivalent to a requirement of an asserted claim if the differences between the [part] [step] and the requirement would be considered not substantial by a person of ordinary skill in the field at the time of the alleged infringement.

[One way to decide whether any difference between a requirement of an asserted claim and a [part] [step] of the [product] [method] is not substantial is to consider whether, as of the time of the alleged infringement, the [part] [step] of the [product] [method] performed substantially the same function, in substantially the same way, to achieve substantially the same result as the requirement in the patent claim].

[In deciding whether any difference between a claim requirement and the [product] [method] is not substantial, you may consider whether, at the time of the alleged infringement, persons of ordinary skill in the field would have known of the interchangeability of the [part] [step] with the claimed requirement. The known interchangeability between the claim requirement and the [part] [step] of the [product] [method] is not necessary to find infringement under the doctrine of equivalents. However, known interchangeability may support a conclusion that the difference between the [part] [step] in the [product] [method] and the claim requirement is not substantial. The fact that a [part] [step] of the [product] [method] performs the same function as the claim requirement is not, by itself, sufficient to show known interchangeability].

[You may not use the doctrine of equivalents to find infringement if you find that [alleged infringer]’s [product] [method] is the same as what was in the prior art before the application for the [ ] patent or what would have been obvious to persons of ordinary skill in the field in light of what was in the prior art. A patent holder may not obtain, under the doctrine of equivalents, protection that it could not have lawfully obtained from the Patent and Trademark Office.]<sup>2</sup>

---

<sup>2</sup> If this instruction is applicable in a given case, then the court should instruct the jury that if [alleged infringer] has made a “prima facie” case that the accused [product] [method] is in the prior art, the burden shifts to the [patent holder] to prove that what it attempts to cover under the doctrine of equivalents is not in the prior art or would not have been obvious from the prior art. See *Fiskares, Inc. v. Hunt Mfg. Co.*, 221 F.3d 1318, 55 USPQ2d 1569 (Fed. Cir. 2000); *Ultra-Tex Surfaces, Inc. v. Hill Brothers Chemical Co.*, 204 F.3d 1360, 53 USPQ2d (Fed. Cir. 2000); *Streamfeeder, LLC v. Sure-Feed Systems, Inc.*, 175 F.3d 974, 50 USPQ2d 1515 (Fed. Cir. 1999).

## Authorities

*Warner-Jenkinson Co., Inc. v. Hilton Davies Chemical Co.*, 520 U.S. 17 (1997); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1480 (Fed. Cir. 1998); *Dolly, Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 397 (Fed. Cir. 1994).

### B.3. Infringement

#### 3.5 MEANS-PLUS-FUNCTION CLAIMS – LITERAL INFRINGEMENT<sup>3</sup>

I will now describe the separate rules that apply to “means-plus-function” requirements that are used in some claims. Claims [ ] in the [ ] patent contain “means-plus-function” requirements. A means-plus-function requirement only covers the specific [structure] disclosed in a patent specification for performing the claimed function and the equivalents of those specific [structure] that perform the claimed function. A means-plus-function requirement does not cover all possible [structure] that could be used to perform the claimed function.

For purposes of this trial, I have interpreted each means-plus-function requirement for you and identified the [structure] in the patent specification that correspond to these means-plus-function requirements. Specifically, I have determined that:

[X. [ ] is [are] the [structure] that perform[s] the [ ] function identified in the means-plus-function requirement of claim [ ].]

[X. [ ] is [are] the [structure] that perform[s] the [ ] function identified in the means-plus-function requirement of claim [ ].]

In deciding if [patent holder] has proven that [alleged infringer]’s [product] includes an element covered by a means-plus-function requirement, you must first decide whether the [product] has any element that performs the function I just described to you. If not, the claim containing that means-plus-function requirement is not infringed.

If you find that the [alleged infringer]’s [accused product] does have an element that performs the claimed function, you must next identify the [structure] in [alleged infringer]’s [accused product] that perform[s] this function. After identifying that [structure], you must then determine whether that [structure] is the same as or equivalent to the [structure] I have identified. If they are the same or equivalent, the means-plus-function requirement is satisfied by that element of the [accused product]. If all the other requirements of the claim are satisfied by elements found in the [accused product], the [accused product] infringes the claim.

In order to prove that [a structure] in the [accused product] is equivalent to the [structure] in the [ ] patent, the [patent holder] must show that a person of ordinary skill in the field would have considered that the differences between the [structure] described in the [ ] patent and the [structure] in the [accused product] are not substantial. The [patent holder] must also show that the [structure] was available on the date the [ ] patent was granted.<sup>4</sup>

---

<sup>3</sup> If a claim at issue is a method claim with a limitation written in “step-plus-function” format, this instruction should be modified accordingly, for example, substituting “acts” for “structure.”

<sup>4</sup> The last sentence of this instruction may be subject to further case law development. Existing Federal Circuit case law does assume that 35 U.S.C. § 112(6) equivalents do not include “later developed technologies,” and that the measuring date should be patent issuance rather than, for example, the effective filing date of the application. See *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 1310 (Fed. Cir. 1998) (the court refers to “a variant . . . developed after the patent is granted.”); *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1320 (Fed. Cir. 1999); *Ishida Co. v. Taylor*, 221 F.3d 1310, 1316 (Fed. Cir. 2000). *Chiuminatta* notes that

## Authorities

*Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1266 (Fed. Cir. 1999); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998); *Micro Chem., Inc. v. Great Plains Chem. Co., Inc.*, 103 F.3d 1538, 1547 (Fed. Cir. 1997); *Valmont Indus., Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993).

---

the reason after-developed variants cannot be section 112(6) equivalents but might be equivalents under the doctrine of equivalents is that the variant “could not have been disclosed in the patent.” The effective filing date fixes what can be disclosed because the Patent Act prohibits the addition of new matter to an application after it is filed. Also, as a general matter, the meaning of a patent's disclosure and of critical claim terms is determined as of the application date and cannot be changed or expanded by post-filing date technological developments. *See Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 1351 (Fed. Cir. 2000). Because claim interpretation, which determines literal infringement is measured as of the filing date, an argument can be made that “later developed technologies” refers to technologies developed after the effective filing date.

### *B.3. Infringement*

#### **3.6 MEANS-PLUS-FUNCTION CLAIMS – INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS**

No model instruction is provided since an instruction on this subject is necessarily case specific. However, a means-plus-function requirement can be met under the doctrine of equivalents if either the function is not the same but equivalent (*see, e.g. WMS Gaming Inc. v. International Game Technology*, 84 F.3d 1339, 1353 (Fed. Cir. 1999) or the corresponding structure in the accused product is later developed technology. *See Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 1310 (Fed. Cir. 1998); *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1320 (Fed. Cir. 1999).

### B.3. Infringement

#### 3.7 LIMITATIONS ON THE DOCTRINE OF EQUIVALENTS

In this action, the doctrine of equivalents analysis cannot be applied to the following requirements of the asserted claims:

[List requirements on a claim-by-claim basis]

Unless each of these requirements is literally present within the [alleged infringer]'s [product] [method], there can be no infringement of the claim.

#### Authorities

*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 569 (Fed. Cir. 2000), cert. granted, 121 S. Ct. 2519 (2001); *K-2 Corporation v. Salomon SA*, 191 F.3d 1356, 1368-69 (Fed. Cir. 1999); *Sextant Avionique v. Analog Devices, Inc.*, 172 F.3d 817, 826 (Fed. Cir. 1999); *YBM Magnex, Inc. v. International Trade Commission*, 145 F. 3d 1317, 1319-21 (Fed. Cir. 1998); *Maxwell v. J. Baker*, 86 F.3d 1098, 1107-08 (Fed. Cir 1996)<sup>5</sup>; *Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174 (Fed. Cir. 1993).

---

<sup>5</sup> *YBM Magnex* and *Maxwell* discuss the issue of whether and under what circumstances a patentee can rely upon the doctrine of equivalents with respect to unclaimed subject matter disclosed in the specification. That issue is now pending before the Federal Circuit *en banc* in *Johnson & Johnson Assocs., Inc. v. R.E. Serv. Co., Inc.*, 238 F.3d 1347 (Fed. Cir. 2001).

### *B.3. Infringement*

#### **3.8 INDIRECT INFRINGEMENT – GENERALLY**

[Patent holder] [also] argues that [alleged infringer] [contributed to infringement by another of] [and] [or] [induced another to infringe] claims [ ] of the [ ] patent. [[Patent holder] has not argued that the [ ] [product] [method] used, manufactured, sold, offered for sale or imported by [alleged infringer] includes all of the requirements of an asserted patent claim]. [Alleged infringer] cannot [contributorily infringe] [or] [induce infringement] unless [patent holder] proves that someone other than [alleged infringer] directly infringes the patent claim by making, using, selling, offering for sale or importing a [product] [method] that includes all of the requirements of the asserted claims. If there is no direct infringement, [alleged infringer] cannot have [contributed to infringement] [or] [induced infringement].

#### Authorities

*Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468-69 (Fed. Cir. 1990); *Met-Coil Sys. Corp. v. Korners Unlimited, Inc.*, 803 F.2d 684, 687 (Fed. Cir. 1986).

### B.3. Infringement

#### 3.9 CONTRIBUTORY INFRINGEMENT

[Patent holder] [also] argues that [alleged infringer] has contributed to infringement by another. Contributory infringement may arise when someone supplies something that is used to infringe one or more of the patent claims.

In order for there to be contributory infringement by [alleged infringer], someone other than [alleged infringer] must directly infringe a claim of the [ ] patent; if there is no direct infringement by anyone, there can be no contributory infringement.

If you find someone has directly infringed the [ ] patent, then contributory infringement exists if:

- (1) [Alleged infringer] supplied an important component of the infringing part of the [product] or [method];
- (2) The component is not a common component suitable for non-infringing use; and
- (3) [Alleged infringer] supplied the component with the knowledge of the [ ] patent and knowledge that the component was especially made or adapted for use in an infringing manner.

#### Authorities

*Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476 (1964); *Mentor H/S, Inc. v. Medical Device Alliance, Inc.*, 244 F.3d 1365 (Fed. Cir. 2001); *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1469 (Fed. Cir. 1990); *Preemption Devices, Inc. v. Minnesota Mining & Mfr. Co.*, 803 F.2d 1170, 1174 (Fed. Cir. 1986).

### *B.3. Infringement*

#### **3.10 INDUCING PATENT INFRINGEMENT**

[Patent holder] argues that [alleged infringer] has actively induced another to infringe the [ ] patent. In order for there to be inducement of infringement by [alleged infringer], someone else must directly infringe a claim of the [ ] patent; if there is no direct infringement by anyone, there can be no inducement of infringement. Active inducement exists if [alleged infringer] actively and knowingly assists or encourages the direct infringement.

In order to induce infringement, [alleged infringer ] must have intended to cause the acts that constitute the direct infringement, and [alleged infringer] must have known or should have known that its actions would cause direct infringement. [[Alleged infringer] cannot be liable for inducing infringement if it was not aware of the existence of the patent].

#### Authorities

*Mentor H/S, Inc. v. Medical Device Alliance, Inc.*, 244 F.3d 1365 (Fed. Cir. 2001); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1311-12 (Fed. Cir. 1998); *Insituform Techs, Inc. v. Cat Contracting, Inc.*, 161 F.3d 688, 695 (Fed. Cir. 1998); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 553-54 (Fed. Cir. 1990); *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468-69 (Fed. Cir. 1990).

### B.3. Infringement

#### 3.11 WILLFUL INFRINGEMENT

In this case, [patent holder] argues both that [alleged infringer] infringed and that [alleged infringer] infringed willfully. To prove willful infringement, [patent holder] must meet a higher standard than the one for infringement. It is not enough for [patent holder] to show that it is “more probable than not” that [alleged infringer] committed willful infringement. [Patent holder] must persuade you instead that it is “highly probable” that [alleged infringer] willfully infringed.

Specifically, [patent holder] must demonstrate that it is highly probable that:

- A. [Alleged infringer] had actual knowledge of the [ ] patent; and
- B. [Alleged infringer] had no reasonable basis for believing (1) that [alleged infringer]’s [product] [method] did not infringe the [ ] patent or (2) that the [ ] patent was invalid [or unenforceable].<sup>6</sup>

In deciding whether [alleged infringer] committed willful infringement, you must consider all of the facts, which include but are not limited to:

- A. Whether [alleged infringer] intentionally copied a product of [patent holder] covered by the [ ] patent;
- B. Whether [alleged infringer], when it knew of [patent holder]’s patent protection, investigated the scope of the patent and formed a good-faith belief that the patent was invalid [or unenforceable] or that it was not infringed;
- C. Whether [alleged infringer] made a good faith effort to avoid infringing the patent; and
- D. Whether [alleged infringer] relied on a legal opinion that appeared to it to be well-supported and believable and that advised [alleged infringer] (1) that the [product] [method] did not infringe the [ ] patent or (2) that the [ ] patent was invalid [or unenforceable].

#### Authorities

*Crystal Semiconductor Corp. v. Tritech Microelectronics Int’l, Inc.*, 246 F.3d 1336, 1346 (Fed. Cir. 2001); *WMS Gaming Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1354 (Fed. Cir. 1999); *Read Corp. v. Portec, Inc.*, 970 F.2d 816 (Fed. Cir. 1992); *Gustafson, Inc. v. Intersystems Indus. Prods., Inc.*, 897 F.2d 508, 510 (Fed. Cir. 1990).

---

<sup>6</sup> If unenforceability is an issue, the court will need to give further instruction to the jury explaining the requirements for the particular theory of unenforceability relied on by [alleged infringer].

*B.4.1 Validity*

**4.1 INVALIDITY – BURDEN OF PROOF**

I will now instruct you on the rules you must follow in deciding whether [alleged infringer] has proven that claims [ ] of the [ ] patent are invalid. To prove invalidity of any patent claim, [alleged infringer] must persuade you that it is highly probable that the claim is invalid.

I will now instruct you on the invalidity issues that you will have to decide in this case.

Authorities

*Buildex, Inc. v. Kason Industries, Inc.*, 849 F.2d 1461, 1463 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1375 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987).

#### 4.2a WRITTEN DESCRIPTION REQUIREMENT

[Alleged infringer] can meet its burden of proving that a patent claim is invalid by showing that the patent does not contain an adequate written description of the claimed invention. In the course of the prosecution of the patent application, the claims may be changed between the time the [original] patent application is first filed and the time the patent is finally granted. An inventor may amend the claims in his or her original application or add new claims. The changes may narrow the scope of the claims in order to distinguish prior art or may broaden their scope to more fully cover the invention. The purpose of the written description requirement is to make sure that the inventor had in mind, that is, had invented at the time the [original] patent application was first filed, the full scope of the invention as finally claimed in the patent. The written description requirement is satisfied if persons of ordinary skill in the field would recognize from the patent application as first filed that the inventor had in mind at that time the full scope of the invention as finally claimed in the patent. A requirement in a claim need not be specifically disclosed in the original patent application if persons of ordinary skill in the field reading that application would understand that the missing requirement must necessarily be present.

##### Authorities

*Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000); *Lampi Corp. v. Am. Power Prods., Inc.*, 228 F.3d 1365, 1377-78 (Fed. Cir. 2000); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478-80 (Fed. Cir. 1998); *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996).

### *B.4.2 Validity—Adequacy of Patent Specification*

#### **4.2b ENABLEMENT**

[Alleged infringer] can meet its burden of proving that a patent claim is invalid by showing that the patent does not contain a description of the claimed invention that is sufficiently full and clear to enable persons of ordinary skill in the field to make and use the invention. This is known as the “enablement” requirement. If a patent claim is not enabled, it is invalid.

The patent is enabling if it permits persons of ordinary skill in the field to make and use the invention without having to do excessive experimentation. Some experimentation is allowable. The factors you may consider in deciding whether any required experimentation is excessive include: the time and cost of any necessary experimentation; how routine any necessary experimentation is; whether the patent discloses specific working examples of the claimed invention; the amount of guidance presented in the patent; the nature and predictability of the field; the level of ordinary skill in the field; and the scope of the claimed invention.

Enablement is tested as of the date the original patent application was first filed.

#### Authorities

*Union Pac. Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 690-92 (Fed. Cir. 2001); *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1345-46 (Fed. Cir. 2000); *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

#### 4.2c BEST MODE

[Alleged infringer] can meet its burden of proving that a patent claim is invalid by showing that the patent does not disclose what [the inventor] [any of the inventors] believed was the best way to carry out the claimed invention at the time the patent application was filed. This is known as the “best mode” requirement. It ensures that the public obtains a full disclosure of the best way to carry out the claimed invention known to [the inventor] [any of the inventors] at the time the [original] patent application was first filed. The disclosure of the best mode must be detailed enough to enable persons of ordinary skill in the field to carry out that mode without excessive experimentation. If the patent does not disclose the best mode of a claim, that claim is invalid.

The best mode requirement focuses on what [the inventor] [any of the inventors] believed at the time the [original] patent application was first filed. It does not matter whether the best mode contemplated by [the inventor] [any of the inventors] was, in fact, the best way to carry out the invention. The question is whether the patent includes what [the inventor] [any of the inventors] believed was the best mode at the time the [original] patent application was filed. If [the inventor did not believe] [none of the inventors believed] there was a best way to carry out the invention at the time that application was filed, there is no requirement that the patent describe a best mode. Although a patent specification must disclose the best mode, it may disclose other modes as well and need not state which of the modes disclosed is best.

#### Authorities

*Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1049-52 (Fed. Cir. 1995); *Transco Prods. v. Performance Contracting*, 38 F.3d 551 (Fed. Cir. 1994); *Wahl Instruments v. Acvious*, 950 F.2d 1575 (Fed. Cir. 1991); *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 926-28 (Fed. Cir. 1990); *Spectra-Physics Inc. v. Coherent, Inc.*, 827 F.2d 1524 (Fed. Cir. 1987).

### *B.4.3 Validity—The Claims*

#### **4.3a1 ANTICIPATION**

A patent claim is invalid if the claimed invention is not new. For a claimed invention to be invalid as not new, all of its requirements must have been present in one prior art reference.

Here is a list of the ways that [alleged infringer] can show that a patent claim was not new [use those that apply to this case]:

[– if the claimed invention was already publicly known or publicly used by others in the United States before [insert date of conception unless in issue]];

[– if the claimed invention was already patented or described in a printed publication anywhere in the world before [insert date of conception unless in issue]. [A reference may be prior art as a publication if at least one copy exists, as long as that one copy is reasonably locatable by and available to those in the field]];

[– if the claimed invention was already made by someone else in the United States before [insert date of conception unless in issue], if that other person had not abandoned the invention or kept it secret];

[– if the claimed invention was already described in another issued or published U.S. patent that was based on a patent application filed before [insert date of the patent holder’s application filing date] [or] [insert date of conception unless in issue]];

[– if [named inventor] did not invent the claimed invention but instead learned of the claimed invention from someone else];

[– if the [patent holder] and [alleged infringer] dispute who is a first inventor, the person who first conceived of the claimed invention and first reduced it to practice is the first inventor. If one person conceived of the claimed invention first, but reduced to practice second, that person is the first inventor only if that person (a) began to reduce the claimed invention to practice before the other party conceived of it and (b) continued to work diligently to reduce it to practice. [A claimed invention is “reduced to practice” when it has been tested sufficiently to show that it will work for its intended purpose or when it is fully described in a filed patent application]].

[Since it is in dispute, you must determine a date of conception for the [claimed invention] [and/or] [prior invention]. Conception is the mental part of an inventive act and is proven when the invention is shown in its complete form by drawings, disclosure to another or other forms of evidence presented at trial.]

As I told you, for the claim to be invalid because it is not new, all of its requirements must be in a single previous device or method, or described in a single previous publication or patent. We call these things “prior art references.” The description in a reference does not have to be in the

same words as the claim, but all the requirements must be there, either stated or necessarily implied, so that someone of ordinary skill in the field looking at that one reference would have everything necessary to make and use the claimed invention.

#### Authorities

*Apotex U.S.A., Inc. v. Merck & Co.*, 254 F.3d 1031, 1035 (Fed. Cir. 2001); *Mycogen Plant Science, Inc. v. Monsanto Co.*, 243 F.3d 1316, 1330 (Fed. Cir. 2001); *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1367-70 (Fed. Cir. 2000); *Singh v. Brake*, 222 F.3d 1362, 1366-70 (Fed. Cir. 2000); *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349 (Fed. Cir. 1998); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1576-78 (Fed. Cir. 1997); *Lamb-Weston, Inc. v. McCain Foods, Ltd.*, 78 F.3d 540, 545 (Fed. Cir. 1996); *In re Bartfeld*, 925 F.2d 1450 (Fed. Cir. 1985); *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1574 (Fed. Cir. 1985).

### **4.3a2 STATUTORY BARS**

A patent claim is invalid if the patent application was not filed within the time required by law. For a patent claim to be invalid here, all of its requirements must have been present in one prior art reference more than a year before the patent application was filed. Here is a list of ways [alleged infringer] can show that the patent application was not timely filed: [choose those that apply]

[– if the claimed invention was already patented or described in a printed publication anywhere in the world before [insert date that is one year before effective filing date of patent application]. [A reference may be prior art as a publication if at least one copy exists, as long as that one copy is reasonably locatable by and available to those in the field]];

[– if the claimed invention was already being openly used in the United States before [insert date that is one year before application filing date] and that use was not primarily an experimental use (a) controlled by the inventor, and (b) to test whether the invention worked for its intended purpose];

[– if a device or method using the claimed invention was sold or offered for sale in the United States, and that claimed invention was ready for patenting, before [insert date that is one year before application filing date]. [The claimed invention is not being [sold] [or] [offered for sale] if the [patent holder] shows that the [sale] [or] [offer for sale] was primarily experimental.] [The claimed invention is ready for patenting if it was actually built, or if the inventor had prepared drawings or other descriptions of the claimed invention that were sufficiently detailed to enable a person of ordinary skill in the field to make and use the invention based on them.]];

[– if the [patent holder] had already obtained a patent on the claimed invention in a foreign country before filing the original U.S. application, and the foreign application was filed at least one year before the U.S. application.]

For a claim to be not new because of a prior art reference dated at least one year earlier than the effective filing date of the patent application, all of the claimed requirements must have been specifically disclosed in the reference, or would have to have been known to a person of ordinary skill in the field to have been necessarily present in the reference. The disclosure in a reference does not have to be in the same words as the claim, but all the requirements must be there, either stated or necessarily implied, so that someone of ordinary skill in the field looking at that one reference would have everything necessary to make and use the claimed invention.

### Authorities

*Pfaff v. Wells Electronics Inc.*, 525 U.S. 55 (1998); *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000); *Abbot Labs. v. Geneva Pharms., Inc.*, 182 F.3d 1315, 1318 (Fed. Cir. 1999); *Finnegan Corp. v. Int'l Trade Comm'n*, 180 F.3d 1354 (Fed. Cir. 1999); *J.A. LaPorte, Inc. v. Norfolk Dredging Co.*, 787 F.2d 1577, 1581 (Fed. Cir. 1986); *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986); *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1150 (Fed. Cir. 1983).

### **4.3b OBVIOUSNESS**

A patent claim is invalid if the claimed invention would have been obvious to a person of ordinary skill in the field [at the time the application was filed] [as of [insert date]]. This means that even if all of the requirements of the claim cannot be found in a single prior art reference, a person of ordinary skill in the field who knew about all the prior art would have come up with the claimed invention. The claimed invention is not obvious unless there was something in the prior art or within the understanding of a person of ordinary skill in the field that would suggest the claimed invention. In other words, you have to be careful not to look at the claimed invention with hindsight and just assume that someone of skill in the field would have thought to do it.

Your conclusion about the question whether a claim is obvious must be based on several factual decisions that you must make. First, you must decide the scope and content of the prior art. Second, you must decide what difference, if any, exists between the claim and the prior art. Third, you must decide the level of ordinary skill in the field that someone would have had at the time the claimed invention was made. Finally, you must consider any evidence that has been presented with respect to the following: [use those that apply to this case]

- [(1) commercial success due to the merits of the claimed invention;]
- [(2) a long felt need for the solution provided by the claimed invention;]
- [(3) unsuccessful attempts by others to find the solution provided by the claimed invention;]
- [(4) copying of the claimed invention by others;]
- [(5) unexpected superior results from the claimed invention;]
- [(6) acceptance by others of the claimed invention as shown by praise from others in the field or from the licensing of the claimed invention; and]
- [(7) independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it.]

[The presence of any of the [list 1-6 as appropriate] considerations may be an indication that a claimed invention would not have been obvious at the time this invention was made, and the presence of the [list 7] consideration may be an indication that the claimed invention would have been obvious at such time. Although you must consider any evidence of these considerations, the importance of any of them to your decision on whether the claimed invention would have been obvious is up to you.]

## Authorities

*Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 991 (Fed. Cir. 1988); *Windsurfing Int'l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1000 (Fed. Cir. 1986), *cert. denied*, 477 U.S. 905 (1986); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 313 (Fed. Cir. 1985).

### *B.4.3 Validity—The Claims*

#### **4.3bi SCOPE AND CONTENT OF PRIOR ART**

[Patent holder] and [alleged infringer] disagree as to whether [identify prior art reference(s)] should be included in the prior art you use to decide the validity of claims [ ] of the [ ] patent. In order to be considered as prior art to the [ ] patent, these references must be reasonably related to the claimed invention of that patent. A reference is reasonably related if it is in the same field as the claimed invention or is from another field that a person of ordinary skill would look to in trying to solve the problem the named inventor was trying to solve.

#### Authorities

*Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664-65 (Fed. Cir. 2000); *Wang Lab. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1993).

### *B.4.3 Validity—The Claims*

#### **4.3bii DIFFERENCES OVER THE PRIOR ART**

In reaching your conclusion as to whether or not claim [    ] would have been obvious at the time the claimed invention was made, you should consider any difference or differences between the [identify prior art] and the claimed requirements.

#### Authorities

*Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Yamanouchi Pharm. Co. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343-45 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935 (Fed. Cir. 1990).

#### **4.3biii LEVEL OF ORDINARY SKILL**

In reaching your decision as to whether the claimed invention would have been obvious at the time it was made, you should also consider the level of ordinary skill in the field of [identify field]. When deciding the level of ordinary skill in [the field], consider all the evidence introduced at trial for this decision, including:

- (1) the levels of education and experience of persons working in the field;
- (2) the types of problems encountered in the field; and
- (3) the sophistication of the technology.

[Patent holder] contends that the level of ordinary skill in the field was [ ]. [Alleged infringer] contends that the level of ordinary skill in the field was [ ]. Based on the factors I have just listed, and the evidence presented, you must decide what was the level of ordinary skill in the field.

#### Authorities

*Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000); *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1355 (Fed. Cir. 2000); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718-19 (Fed. Cir. 1991).

#### 4.3c INVENTORSHIP

[Alleged infringer] can meet its burden of proving that a patent is invalid by showing that it fails to meet the requirement to name all actual inventors and only the actual inventors. This is known as the “inventorship” requirement. To be an inventor, one must make a significant contribution to the conception of one or more claims of the patent. Persons may be inventors even though they do not physically work together or make the same type or amount of contribution, or contribute to the subject matter of each claim of the patent. However, merely helping with experimentation or explaining to the actual inventors well-known concepts or the current state of the art does not make someone an inventor.

##### Authorities

*Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349 (Fed. Cir. 1998); *Hess v. Advanced Cardiovascular Sys.*, 106 F.3d 976, 980 (Fed. Cir. 1997); *Burroughs Wellcome Co. v. Barr Lab.*, 40 F.3d 1223, 1227-28 (Fed. Cir. 1994); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985).

### **5.1 DAMAGES – BURDEN OF PROOF**

I will instruct you about the measure of damages. By instructing you on damages, I am not suggesting which party should win on any issue. If you decide that any claim of the [ ] patent has been infringed and is not invalid, you must then determine the amount of any money damages to be awarded to [patent holder] to compensate it for the infringement.

The amount of those damages must be adequate to compensate the patent holder for the infringement. A damages award should put the patent holder in approximately the financial position it would have been in had the infringement not occurred, but in no event may the damages award be less than a reasonable royalty.

The patent holder has the burden to persuade you that it is more likely than not that it suffered the damages it seeks. While the patent holder is not required to prove damages with mathematical precision, it must prove its damages with reasonable certainty. The patent holder is not entitled to damages that are remote or speculative.

#### Authorities

*Grain Processing Corp. v. American Maize-Prod. Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1108-09 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1545 (Fed. Cir. 1995) (*en banc*).

## **5.2 LOST PROFITS – GENERALLY**

In this case, [patent holder] seeks to recover lost profits for some of [alleged infringer]’s sales of [infringing product], and a reasonable royalty on the rest of [alleged infringer]’s sales.

To recover lost profits for infringing sales, [patent holder] must show that but for the infringement there is a reasonable probability that it would have made sales that [alleged infringer] made of the infringing product. [Patent holder] must show the share of [alleged infringer]’s sales that it would have made if the infringing product had not been on the market.

### Authorities

*Aro Mfg. Co. v. Convertible Top Co.*, 377 U.S. 476, 502-07 (1964); *Central Soya Co. v. George A. Hormel & Co.*, 723 F.2d 1573, 1579 (Fed. Cir. 1983); *Lam, Inc. v. Johns-Mansville Corp.*, 718 F.2d 1056, 1065 (Fed. Cir. 1983).

### *B.5. Patent Damages*

#### **5.3 LOST PROFITS – FACTORS TO CONSIDER**

One way [patent holder] may be entitled to lost profits is by proof of all of the following:

- (1) that there was a demand for the patented product;
- (2) that there were no non-infringing substitutes, or, if there were, the number of the sales made by [alleged infringer] that [patent holder] would have made despite the availability of other acceptable non-infringing substitutes;
- (3) that [patent holder] had the manufacturing and marketing capacity to make the infringing sales or a portion thereof actually made by the infringer; and
- (4) the amount of profit that [patent holder] would have made had [alleged infringer] not infringed.

#### Authorities

*Gargoyles, Inc. v. United States*, 113 F.3d 1572, 1577-78 (Fed. Cir. 1997); *Carella v. Starlight Archery*, 804 F.2d 135, 141 (Fed. Cir. 1986); *Gyromat Corp. v. Champion Spark Plug Co.*, 735 F.2d 549, 552 (Fed. Cir. 1984); *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156 (6<sup>th</sup> Cir. 1978).

### *B.5. Patent Damages*

#### **5.4 LOST PROFITS – COLLATERAL SALES**

In this case, [patent holder] is seeking profits from sales of [ x ], which it contends it would have sold along with [ y ]. These products are called collateral products.

To recover lost profits on sales of such collateral products, [patent holder] must prove two things. First, that it is more likely than not that [patent holder] would have sold the collateral products but for the infringement. Second, that the collateral products worked together with the patented product in some manner so as to produce a desired end product or result.

#### Authorities

*Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1550 (Fed. Cir. 1995) (*en banc*); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1580 (Fed. Cir. 1989); *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1157-58 (6<sup>th</sup> Cir. 1978).

## *B.5. Patent Damages*

### **5.5 LOST PROFITS – PRICE EROSION**

[Patent holder] is entitled to recover additional damages if it can show to a reasonable probability that, if there had been no infringement, [patent holder] would have been able to charge higher prices for some of its products. In that case, you may also award as additional damages the amount represented by the difference between the amount of profits that [patent holder] would have made by selling its product at the higher price and the amount of profits [patent holder] actually made by selling its product at the lower price that [patent holder] charged for its product. This type of damage is referred to as price erosion damage.

If you find that [patent holder] suffered price erosion, you may also use the higher price in determining [patent holder]'s lost profits from sales lost because of the infringement. In calculating a patentee's total losses from price erosion, you must take into account any drop in sales that would have resulted from a higher price.

You may also award as damages the amount of any increase in costs of [patent holder], such as additional marketing costs, caused by competition from the infringing product.

#### Authorities

*Crystal Semiconductor Corp. v. Tritech Microelectornics Int'l, Inc.*, 246 F.3d 1336 (Fed. Circ. 2001); *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1120 (Fed. Cir. 1996); *Kalman v. Berlyn Corp.*, 914 F.2d 1473, 1485 (Fed. Cir. 1990).

### *B.5. Patent Damages*

#### **5.6 REASONABLE ROYALTY – ENTITLEMENT**

If [patent holder] has not proved its claim for lost profits, or has proved its claim for lost profits for only a portion of the infringing sales, then [patent holder] is entitled to a reasonable royalty. [Patent holder] is entitled to a reasonable royalty for all infringing sales for which it is not entitled to lost profits damages.

#### Authorities

*Crystal Semiconductor Corp. v. Tritech Microelectornics Int'l, Inc.*, 246 F.3d 1336 (Fed. Circ. 2001); *Fromson v. Western Litho Plate & Supply Co.*, 853 F.2d 1568, 1574 (Fed. Cir 1998); *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1119-20 (Fed. Cir. 1996); *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1554 (Fed. Cir. 1995) (*en banc*).

### *B.5. Patent Damages*

#### **5.7 REASONABLE ROYALTY – DEFINITION**

A royalty is a payment made to a patent holder by a non-owner in exchange for rights to make, use or sell the claimed invention. A reasonable royalty is the payment that would have resulted from a negotiation between a patent holder and the infringer taking place at the time when the infringing sales first began. In considering the nature of this negotiation, the focus is on what the expectations of the patent holder and infringer would have been had they entered into an agreement at that time and acted reasonably in their negotiations. In addition, you must assume that patent holder and infringer were willing to enter into an agreement; your role is to determine what that agreement would have been.

#### Authorities

*Maxwell v. Baker, Inc.*, 86 F.3d 1098, 1108-10 (Fed. Cir. 1996); *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579-81 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1554 (Fed. Cir. 1995) (*en banc*); *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970).

## B.5. Patent Damages

### 5.8 DATE OF COMMENCEMENT– PRODUCTS<sup>7</sup>

Damages that [patent holder] may be awarded by you commence on the date that [alleged infringer] has both infringed and been notified of the [ ] patent: [use those that apply to this case]

[– [Patent holder] and [alleged infringer] agree that date was [insert date]];

[– Since [patent holder] sells a product that includes the claimed invention but has not marked that product with the patent number, you must determine the date that [alleged infringer] received actual written notice of the [ ] patent and the specific product alleged to infringe];

[– Since [patent holder] [marks the product] or [does not sell a product covered by the patent], then damages begin without the requirement for actual notice under the following circumstances:

If the [ ] patent was granted before the infringing activity began, damages should be calculated as of the date you determine that the infringement began; or

If the [ ] patent was granted after the infringing activity began as determined by you, damages should be calculated as of [date patent issued].]

#### Authorities

*Crystal Semiconductor Corp. v. Tritech Microelectornics Int'l, Inc.*, 246 F.3d 1336 (Fed. Circ. 2001); *Nike Inc. v. Wal-Mart Stores*, 138 F.3d 1437, 1443-44 (Fed. Cir. 1998); *Maxwell v. Baker, Inc.*, 86 F.3d 1098, 1108-09 (Fed. Cir. 1996); *American Med. Sys. v. Medical Eng'g Corp.*, 6 F.3d 1523, 1534 (Fed. Cir. 1993); *Devices for Med., Inc. v. Boehl*, 822 F.2d 1062, 1066 (Fed. Cir. 1987).

---

<sup>7</sup> This instruction may be used when the claim is an apparatus or product claim and [alleged infringer] is a direct infringer. Different rules may apply if the claim is a method claim or [alleged infringer] is an inducer or contributory infringer.

## **GLOSSARY**

**Some of the terms in this glossary will be defined in more detail in the legal instructions you are given. The definitions in the instructions must be followed and must control your deliberations.**

[Add any technical terms from the art involved that may be used during trial and have agreed-upon definitions and delete any of the following terms which may not be applicable in a particular case.]

**Abstract:** A brief summary of the technical disclosure in a patent to enable the U.S. Patent and Trademark Office and the public to determine quickly the nature and gist of the technical disclosure in the patent.

**Amendment:** A patent applicant's change to one or more claims in response to an office action taken by a Patent Examiner during the patent application examination process.

**Anticipation:** A situation in which a claimed invention is too similar to an earlier invention to be considered new and, thus, entitled to be patented. If the invention as described in a numbered claim of a patent already existed with all of its requirements in a single piece of prior art, the claim is invalid.

**Assignment:** A transfer of patent rights to another called an "assignee" who upon transfer becomes the owner of the rights assigned.

**Best Mode:** The best way the inventor actually knew to make or use the invention at the time of the patent application. If the applicant had a best mode as of the time the application was filed, it must be set forth in the patent specification.

**Claim:** Each claim of a patent is a concise, formal definition of an invention and appears at the end of the specification in a separately numbered paragraph. In concept, a patent claim marks the boundaries of the patent in the same way that a legal description in a deed specifies the boundaries of land, i.e. similar to a land owner who can prevent others from trespassing on the bounded property, the inventor can prevent others from using what is claimed. Claims may be independent or dependent. An independent claim stands alone. A dependent claim does not stand alone and refers to one or more other claims. A dependent claim incorporates whatever the other referenced claim or claims say.

**Conception:** The complete mental part of the inventive act which must be capable of proof, as by drawings, disclosure to another, etc.

**Drawings:** The drawings are visual representations of the claimed invention contained in a patent application and issued patent, and usually include several figures illustrating various aspects of the claimed invention.

**Elements:** The parts of a device. A device infringes a patent if it contains elements which meet each requirement of a patent claim.

**Embodiment:** A product or method that contains the claimed invention.

**Enablement:** A description of the invention that is sufficient to enable persons skilled in the field of the invention to make and use the invention. The specification of the patent must contain such an enabling description.

**Examination:** Procedure before the U.S. Patent and Trademark Office whereby a Patent Examiner reviews the filed patent application to determine if the claimed invention is patentable.

**Filing Date:** Date a patent application, with all the required sections, has been submitted to the U.S. Patent and Trademark Office.

**Infringement:** Violation of a patent occurring when someone makes, uses or sells a patented invention, without permission of the patent holder, within the United States during the term of the patent. Infringement may be direct, by inducement, or contributory. Direct infringement is making, using or selling the patented invention without permission. Inducing infringement is intentionally causing another to directly infringe a patent. Contributory infringement is offering to sell or selling an item that is a significant part of the invention, so that the buyer directly infringes the patent. To be a contributory infringer one must know that the part being offered or sold is designed specifically for infringing the patented invention and is not a common object suitable for non-infringing uses.

**Limitation:** A required part of an invention set forth in a patent claim. A limitation is a requirement of the invention. The word “limitation” is often used interchangeably with the word “requirement.”

**Nonobviousness:** One of the requirements for securing a patent. To be valid, the subject matter of the invention must not have been obvious to a person having ordinary skill in the field of the invention at the time of the earlier of the filing date of the patent application or the date of invention.

**Office Action:** A written communication from the Patent Examiner to the patent applicant in the course of the application examination process.

**Patent:** A patent is an exclusive right granted by the U.S. Patent and Trademark Office to an inventor to prevent others from making, using or selling an invention for a term of 20 years from the date the patent application was filed (or 17 years from the date the patent issued.) When the patent expires, the right to make, use or sell the invention is dedicated to the public. The patent has three parts, which are a specification, drawings and claims. The patent is granted after examination by the U.S. Patent and Trademark Office of a patent application filed by the inventor which has these parts, and this examination is called the prosecution history.

**Patent and Trademark Office (PTO):** An administrative branch of the U.S. Department of Commerce that is charged with overseeing and implementing the federal laws of patents and trademarks. It is responsible for examining all patent applications and issuing all patents in the United States.

**Prior Art:** Previously known subject matter in the field of a claimed invention for which a patent is being sought. It includes issued patents, publications, and knowledge deemed to be publicly available such as trade skills, trade practices and the like.

**Prosecution History:** The prosecution history is the complete written record of the proceedings in the PTO from the initial application to the issued patent. The prosecution history includes the office actions taken by the PTO and the amendments to the patent application filed by the applicant during the examination process.

**Reads On:** A patent claim “reads on” a device or method when each required part (requirement) of the claim is found in the device or method.

**Reduction to Practice:** The invention is “reduced to practice” when it is sufficiently developed to show that it would work for its intended purpose.

**Requirement:** A required part of an invention set forth in a patent claim. The word “requirement” is often used interchangeably with the word “limitation.”

**Royalty:** A royalty is a payment made to the owner of a patent by a non-owner in exchange for rights to make, use or sell the claimed invention.

**Specification:** The specification is a required part of a patent application and an issued patent. It is a written description of the invention and of the manner and process of making and using the claimed invention.